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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,261	04/12/2001	Hans-Michael Kuhl	22750/405A	5004

26646 7590 11/26/2002

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ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

**Office Action Summary**

Application No.

09/835,261

Applicant(s)

KUHL ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the amendment submitted on September 11, 2002.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' remarks and amendments, the previous rejections of claims 1-6 are withdrawn. However, the previous rejections of claim 6 as to insufficient antecedent basis for "the granular particles" and the indefinite phrase "in and of themselves" are maintained as previously stated in the Office Action submitted on June 6, 2002.

### ***Claim Rejections - 35 USC § 103***

**Claims 1-3 and 5-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Payn et al., U.S. Pat. No. 6,017,586 as previously stated in the Office Action submitted on June 6, 2002.

### ***Response to Arguments***

Applicants' argument filed September 11, 2002 have been fully considered but they are not persuasive.

On pages 4-5, Applicants argue that Payn provides a list of ingredients that can be interchangeably used to produce its polymer material but that Payn does not disclose or suggest the claimed composition. Examiner disagrees because Applicants claim that the floor covering comprises a copolymer of ethylene and at least one comonomer of an alpha-olefin having 4-10 C-atoms. Payn also shows this floor covering comprising a copolymer of ethylene and alpha-

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olefin with 10 or more C-atoms (column 15, lines 44-45). Even though Payn shows that the polymers can be used “interchangeably,” Payn still shows the same components as in the instant invention.

On page 5, Applicants argue that Payn suggests that its invention is suited for fluid application to a fabric substrate and that as a result, the invention of Payn is not necessarily identical or similar to the instant floor covering. Examiner disagrees because Payn does definitely show the “floor covering” as in instant claim 1. Even though Payn may show that it’s invention is suited for fluid application to a fabric substrate, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It does not matter what the intended use is in an article claim. The invention of Payn shows Applicants’ invention without any structural differences. Thus, Payn shows a “floor covering,” which is the intended use of Applicants’ invention. The prior art structure of Payn thus meets the claims of Applicant’s disclosure. Further, Applicants have not claimed a substrate in claim 1 which is not shown in Payn. Applicants have only claimed a floor covering of which is shown in Payn.

On pages 5-6, Applicants argue that there is no suggestion or support in the Payn to show that it is obvious to modify the conditions of a composition due to routine experimentation. Examiner is not persuaded because Payn shows in column 1, lines 39-46 that the improvements in the invention of Payn included low temperature flexibility, weatherability, tensile properties, and abrasion resistance and in column 2, lines 17-25, Payn shows improvements in impact strength, stronger bonding to the fabric, and printability and paintability. Such improvements are

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obviously achieved by, for example, adjusting and optimizing the concentration of the P/M fluid (column 7, lines 37-67) and by adjusting and optimizing the viscosity of the polymer coatings to obtain suitable physical properties such as thickness (column 1, line 55 to column 2, line 25).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen  
Examiner  
November 24, 2002

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read 'C. H. Kelly', written in a cursive style.